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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,133	06/30/2003	Etsuo Oogami	040302-0329	3017
22428	7590	09/06/2006	EXAMINER	
FOLEY AND LARDNER LLP			KALAFUT, STEPHEN J	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1745	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,133

Applicant(s)

OOGAMI, ETSUO

Examiner

Stephen J. Kalafut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10 is/are rejected.
- 7) ☒ Claim(s) 7-9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date (<u>3 dates</u>). | 6) <input type="checkbox"/> Other: ____. |

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Claims 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “freely connectable capabilities” is unclear. How may an abstract noun such as “capability” be concretely connected to something?

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 6, respectively, of copending Application No. 10/608,134. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present details of claim 1 are found in claim 4 of the ‘134 application, which depends from claim 1 thereof. Claim 1 of the ‘134 application recites a “power generating element hermetically sealed in a package film” and that “a plurality

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of the cells are stacked on one another”. Claim 4 of the ‘134 application adds “wherein each of the cells is mounted and held on a frame-shaped holder” and “the electrode tab of the cell is exposed from between the cell holders adjacent to each other in the stacking direction”. Claim 4 of the ‘134 application would thus fall within the scope of present claim 1. Claim 6 of the ‘134 application adds the same details as present claim 2.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 5 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/608,134 in view of Lund *et al.* (US 5,470,679). These claims differ from claim 4 of the ‘134 application by reciting sealing surfaces between the cell holders and cell terminals, or sealing members between the cell holders. Lund *et al.* disclose a stack of battery cells that include outer frames (32, 34, 36) that sealingly engage cell connectors (figure 2A) or which include sealing members (70) between adjacent frames (figure 3A). Because of the mechanical stability afforded by these features, it would be obvious to use the connector-engaging surfaces or the sealing members of Lund *et al.* with the cell holders of claim 4 of the ‘134 application.

This is a provisional obviousness-type double patenting rejection.

Claim 4 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/608,134 in view of Hellmann *et al.* (US 6,512,347). This claim differs from claim 4 of the ‘134 application by

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reciting a plate heat sink between adjacent cell holders. Hellmann *et al.* disclose a stack of cells including plate-shaped heat sinks (36) between adjacent cells (12). Because of the safety provided by removing heat generated by battery cells, it would be obvious to use the heat sinks of Hellmann *et al.* between the cells of claim 4 of the '134 application.

This is a provisional obviousness-type double patenting rejection.

Claims 7-9, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The module battery including a plurality of subassemblies of cells and holders, which also includes a module case, and either a wedge-shaped spacer or a space which is divided into tab exposure space and ventilation space, is not disclosed by the prior art, or taught to be an obvious modification of the subject matter claimed in the '134 application.

Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. This claim depends from claim 7, discussed above.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watanabe *et al.* (US 6,899,975) disclose a battery back including stacked cells. Kruger *et al.* (US 2005/0031946) discloses a battery comprising a stack of sealed cells, held by a frame. Higashino (US 7,074,517) has issued from applicant's Serial No. 10/608,032.

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The disclosure is objected to because of the following informalities: The numeral 46b, in figure 2, does not appear in the specification. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sjk



STEPHEN KALAFUT
PRIMARY EXAMINER
GROUP

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